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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,427	04/03/2006	Hans Haindl	2565/145	7575
26646 7590 10/24/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER OSINSKI, BRADLEY JAMES				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
10/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/574,427

**Applicant(s)**

HAINDL ET AL.

**Examiner**

BRADLEY J. OSINSKI

**Art Unit**

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 34-39 and 41-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker (5,718,682).

- a. Regarding claim 34, Tucker discloses a chamber 34 for receiving active substances and that is arranged in a housing 42 and closed by a piercable membrane (septum) 44. Also disclosed is a connecting piece 60 which is capable of connecting to a catheter and is in fluid communicating with chamber 34. Finally, Tucker discloses clamping jaws 56a and 56b which connect to the housing as in figure 5. The clamping jaws are opposite one another. In a first position (figure 6) the clamps are laterally spaced from the housing 54 and moves to a second position (figure 5) where clamps 56 are capable of fixing a catheter between the clamping faces 64 depending on how the catheter is arranged along tube 60.

- b. Regarding claim 35, Tucker discloses the housing and ring halves are made of a plastic material (Col.4 lines 35-40) such as polyethersulfone (Col.2 lines 56-58). Polyethersulfone is a resilient plastic as explained in other patents or publications such as Blake (2006/0064161) and van Woeseik (5,452,386)

- c. Regarding claim 36, Tucker discloses welding the parts together at their interfaces (Col.4 lines 38-41) Arms 56a and 56b fit around the sides of housing part 54 and is fastened to the second housing part 42 via welding along all interfaces, including the end opposite connecting piece 64.
- d. Regarding claim 37, Figure 3 demonstrates a view of the second position. As can be seen, clamping jaws 54 are secured to the house by latching into grooves on both parts of the housing 42 and 54.
- e. Regarding claim 38, Tucker discloses groove 66 to guide the clamping jaws and connecting piece, which are integral with one another.
- f. Regarding claim 39, Tucker discloses an alternative embodiment in figure 2 in which the lower opening 22 in housing 12 acts as a guide groove which has steps that lock latch hooks 22. Such hooks/barbs are capable of being added to the clamping jaws 56.
- g. Regarding claim 41, Tucker discloses an insert element 54 that is locked in an opening in housing portion 42 via heat welding (Col.4 lines 38-40). It is also possible to lock insert element 16 to housing portion 12 via barbs 26. Furthermore from the difference between figures 3 and 4, it is apparent the insert element exerts pressure on the membrane 44 as the membrane's edges are squeezed in figure 3.
- h. Regarding claims 42-44, Tucker discloses ridges 22 that may fit inside indentation rings to form a bayonet connection.

- i. Regarding claims 45-47, As can be seen in figure 3, mutually aligning holes are provided in the housing via 66, insert element 45 at 62 and in the clamping jaws at 64. Cannula 60 progresses through all three holes.
- j. Regarding claim 48, Since the lateral undercut proceeds all the way around the insert element and housing, a segment of the lateral undercut and mutually aligning holes are diametrically opposite one another.
- k. Regarding claims 49 and 50, Tucker discloses that the insert element (cup) is preferably welded to the housing (Col.2 lines 24-26). As the insert element and housing are adhered together, they are adhesively-bound.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker (5,718,682) as applied to claim 34 above, and further in view of Dillon et al (6,165,157).

- i. Regarding claim 40, While Tucker substantially discloses the apparatus as claimed, it does not disclose spigots and holes that are associated with one another and engage. However, Dillon et al provides spigots 66 and holes 68 in figure 4 to bind the two sides of the needle guard to each other, so that the needle guard does not fall off of the catheter 12. Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to provide spigots and holes as taught by Dillon et al to the clamping jaws of Tucker as such is a known method of securing two pieces together that encircle another piece, additionally, the holes and spigots would assist in lining up the clamping jaws and binding the clamping jaws together more firmly.

3. Claims 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker (5,718,682) as applied to claims 34, 48, 60, 61 or 62 above, and further in view of Felix et al (5,167,638).

m. Regarding claims 51 and 52, While Tucker substantially discloses the apparatus as claimed, it does not disclose the way in which the port is made. However, Felix et al teaches injection molded plastic base (Col.2 lines 55-57) for a subcutaneous port. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the base of Tucker via injection molding as taught by Felix et al as such is a known technique of forming plastics into appropriate shapes.

#### ***Response to Arguments***

4. Applicant's arguments filed 8-12-2008 have been fully considered but they are not persuasive.

n. Applicant argues the clamping jaws are not movable between the first are second positions is not persuasive. As Applicant pointed out, figure 6 is the exploded view of the cup. However, the clamping jaws as currently claimed are

not required to be connected to the housing at all times. Before the clamping jaws are connected to each other (i.e. exploded view), they are spaced apart from each other laterally, and then a second position exists when they clamp around the cup 54. Permanently welding the two halves together only prevents further movement from the second to the first position.

o. Applicant argues that the catheter may not be inserted over the outlet tube between the cup ring halves. However, as claimed, the catheter is not required to contact the clamping faces. For example, fixing the connecting piece 60 in place via the clamping action, also fixes the catheter attached to connecting piece 60 in place as well. The clamping faces may be considered the entire interior faces of clamps 56a and 56b and by extension, the catheter is fixed in place between the clamping faces.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADLEY J. OSINSKI whose telephone number is (571)270-3640. The examiner can normally be reached on M-Th 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley J Osinski/  
Examiner, Art Unit 3767  
/Kevin C. Simons/  
Supervisory Patent Examiner, Art Unit 3767